

SP



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,822	01/08/2002	Fung-Jou Chen	13,042.4	9638

23556 7590 01/11/2005

KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXAMINER

STEPHENS, JACQUELINE F

ART UNIT PAPER NUMBER

3761

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,822

Applicant(s)

CHEN ET AL.

Examiner

Jacqueline F Stephens

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36,37 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36,37 and 40-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

- a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification fails to adequately teach how to make and/or use the invention.

Applicant has claimed a number of test results that the article exhibit. Applicant has not disclosed one example of combination of materials and structure that allow the claimed results to occur. No best mode has been disclosed by the applicant. What is the structure of the invention and materials used that allow the web to exhibit the claimed wet compressed bulk of claim 1. Making an invention consistent with the claims would involve undue experimentation. Applicant has not given any guidance as to how to make a web that would have the claimed results. Additionally, the rewet value

Art Unit: 3761

claimed in claim 46 requires "proper application" of the hydrophobic material to the basesheet (specification page 43, lines 20-21), what is the proper application of the hydrophobic material that would meet the claimed rewet value?

2. Claims 36, 37, 40-48 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the fact that there is not an example provided in the specification of the structure and materials used that would provide the article with the claimed test results.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 36, 37, 40-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claim 36, where exactly is the hydrophobic matter deposited? "Preferentially" renders the claim indefinite because the examiner does not know if applicant is claiming the hydrophobic matter as being on the elevated regions or if this is just an option.

As to claims 43 and 47, the limitation "the 50% material line" lacks antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 36, 37, 40-42, 44, 45, and 47, as best understood by the examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Ahr et al. USPN 5763044.

As to claim 36, Ahr discloses a method for producing an absorbent web having a dry feel when wet (Abstract) comprising the steps of: preparing an inherently hydrophilic basesheet comprising papermaking fibers (col. 6, lines 40-45) and having an upper surface and a lower surface, the upper surface having elevated and depressed regions (Figure 7); and depositing hydrophobic matter (col. 5, lines 63-65) preferentially on the elevated regions of the upper surface of the base sheet (Figure 7). The claimed test results are arrived at by performing the disclosed test procedures. The process of performing the tests are part of the method of producing the claimed article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re

Art Unit: 3761

Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

MPEP 2113.

As to claim 37, Ahr incorporates by reference (col. 4, lines 49-55) Benz USPN 3881987 who discloses a method of making an apertured topsheet involving the steps of depositing an aqueous slurry of cellulosic fibers on a foraminous web to produce an embryonic web; molding the web on a three-dimensional substrate; and drying the web (Ahr col. 4, lines 49-66 and Benz col. 11, line 56 through col. 14, line 8).

As to claim 40, Ahr discloses the base sheet is wetlaid (col. 4, lines 34-36).

As to claim 41, Ahr discloses the base sheet is airlaid (col. 4, lines 27-29).

As to claim 42, see Figure 7, the hydrophobic matter comprises fibrils **54**.

As to claim 44, see Figure 7, the hydrophobic matter comprises fibrils **54**, which extend into the apertures of basesheet **52**.

As to claim 45, Ahr discloses 9-400 apertures per square inch (the number of apertures corresponds to the number of protrusions per square inch), which is included in the range of 5-300 protrusions per square inch (col. 5, lines 4-6). Ahr incorporates by reference (col. 4, lines 49-55) Benz USPN 3881987 who discloses the height of the

Art Unit: 3761

apertures is .254-1.01 mm (col. 9, lines 6-10 Benz discloses area and diameter of apertures, from which the examiner calculated the height).

As to claim 47, see Figure 7.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 43, 46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahr USPN 5763044.


As to claims 43 and 46, Ahr does not disclose the exact amount of hydrophobic matter attached to the upper surface or the Rewet value. It is evident that Ahr has a value for this characteristic. Ahr recognizes that the choice of fibril length and fibril density (amount attached to the surface) can be varied and this will affect the rewet characteristics (col. 5, lines 59-60). Ahr, therefore recognizes the Rewet value is a result effective variable of fibril length and density. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Ahr with the claimed amount of synthetic fibers attached to the upper surface and the claimed Rewet value, since discovering an optimum value of a result effective variable involves only routine skill in the art.

As to claim 48, Ahr discloses the basis weight of the base sheet is .058-14.6 g/m² (col. 10, lines 31-32), which is included in the range of from about 10-70 gsm. Ahr is silent on the basis weight of the hydrophobic matter. It is evident that Ahr has a value for this characteristic. Ahr recognizes that the choice of fibril length and fibril density, which is affected by the fibril basis weight, can be varied and this will affect the rewet characteristics (col. 5, lines 59-60). Ahr, therefore recognizes the function of the topsheet in terms of rewet, acquisition, and tactile feel is a result effective variable of fibril length and density. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Ahr with the claimed basis weight of the hydrophobic matter, since discovering an optimum value of a result effective variable involves only routine skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571)272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Examiner
Art Unit 3761

January 5, 2005